

REMARKS/ARGUMENTS

This is in response to the official action dated January 24, 2006. Reconsideration is respectfully requested.

In the current amendment, applicants amended claims 1, 2, 4, 5, 7, 9, 10, 11, 16 and 17 and canceled claims 2, 6, 8, 13 and 18-20.

Claims 1-12 and 14-18 were rejected under 35 USC 112, 2<sup>nd</sup> paragraph. Applicants submit that the claim 1 was amended to clearly state that "a polymer backing sheet having a top face and a bottom face and an interior portion between the top face and the bottom face, the interior portion includes a layer of homogeneous opaque colorant" ... "and wherein the polymer backing sheet includes means for web edge guided optical recognition for dispensing the punched shaped parts."

Method claim 11, as amended includes a similar limitation. All remaining claims are either directly or indirectly dependent on independent claim 1 or 11, thus they include the same limitation.

As was stated on page 3 of the specification "The coloring of the backing sheet or, respectively, the application of the color layer ensures sufficient optical contrast which makes it possible to guide optical recognition systems during the punching process".

Applicants submit that the claims, as amended, particularly point out and claim the subject matter of the invention.

The Examiner rejected claims 1-12 and 14-18 as being obvious over Greuse in view of Higgins. The primary reference of Greuse teaches "a way for effecting coloration of the silicone release layer without changing the peel of a pressure sensitive adhesive coated facing layer, nor the adhesive characteristics thereof." To that end, Greuse discloses a pressure-sensitive laminate composition which enables the easy detection of improperly die-cut patterns which has a backing material, a silicone release coating, a non-migratory colorant dispersed in the silicone, a pressure-sensitive adhesive, and a face stock. Alternatively, a release liner composition is described having a non-migratory silicone coating on a backing material. One colorant used is carbon black. The carbon black is dispersed in the release layer either in a solvent-free system, or in an

organic medium. As can be clearly seen in the Greuse reference, the colored release layer is identified with numeral 16 in fig. 1 (*inter alia*). This layer is an entirely different layer than the backing layer 18. Actually, the colored release layer is sandwiched between the backing layer and the adhesive layer, which is below the face stock layer. Thus, not only does Greuse disclose an entirely additional layer in contrast to applicants' claimed invention, the distribution of the colorant is also different. As stated several time during the prosecution and also as claimed, only Applicant's interior portion of the backing sheet includes the colorant. This is by design, since applicants' invention concerns the a solution of maintaining the punching tools in sharp operation condition, since certain colorants which also are present on the surface have a abrasive characteristic and dull the punching tools. Thus, in contrast to Greuse, Applicant's invention claims that it is the polymer backing sheet which has a top face and a bottom face and an interior portion disposed between the top face and the bottom face, which includes a layer of homogeneous opaque colorant, and the top and/or the bottom face include anti-adhesive coating. Applicants therefore propose a solution to an existing problem which results in time consuming shut down of the production site in order to readjust and or re-sharpen the punching tools. Interruption of production requires human supervision and additional expense for the manufacturer.

The secondary references of Higgins can not take away the fact that the primary reference utilizes a colored release layer, instead of colored backing sheet. The fact that Higgins teaches a polymer backing sheet does not add any information concerning Greuse' colored release liner. A combination of the Higgins and Greuse is therefore impermissible hindsight. The Action fails to point out and Applicant fails to find a suggestion or motivation in either the Greuse or Higgins to combine the references. The Greuse reference does not suggest any unresolved challenges with regard to colored release layer, and Higgins does not suggest employing a release layer. Although, the statement on page 5 of the Action asserting that, "It would have been obvious ... to combine the teachings of Greuse and Higgins since each of the aforementioned references are analogous insofar as being directed at silicone release liners and are both concerned with minimizing silicone debris production" misses completely the purpose of the present invention. Even if it were the motivation driving the inventor in the instant case, the only potential teaching for any such motivation is Applicant's own patent application. Using Applicant's own invention

to supply the motivation for combining references is inappropriate. As stated in MPEP §2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ 1430 (Fed. Cir. 1990). As that section further states, "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' " *In re Mills*, 916 F.2d at 682. See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Applicant therefore submits that claims independent claim 1 and all remaining dependent claims, being directly or indirectly dependent on claim 1, as amended herein, are patentable over Greuse and Higgins, and allowance is respectfully requested.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,  
NORRIS McLAUGHLIN & MARCUS, P.A.

By Christa Hildebrand  
Christa Hildebrand  
Reg. No. 34,953  
875 Third Avenue - 18<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 808-0700  
Fax: (212) 808-0844  
Facsimile: (212)808-0844